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REEXAM UNIT

In re Application of
Oshima, et. al.
Application No. 09/672,946
Filed: Sept. 29, 2000
Attorney Docket No. 2000-1328

DECISION GRANTING
PETITION UNDER
37 CFR 1.183

This is a decision on the June 9, 2004, "Petition Under 37 CFR 1.183 to Accept Substitute Specification in Reissue Application" requesting waiver of the 37 CFR 1.125(d) prohibition against the filing of a substitute specification in a reissue application. The petition is being treated pursuant to 37 CFR 1.183 as a request for waiver of 37 CFR 1.173(a)(1) in addition to waiver of 37 CFR 1.125(d).

The petition is before the Office of Patent Legal Administration of the United States Patent and Trademark Office.

The petition is granted.

DECISION

37 CFR 1.125(d) prohibits the filing of a substitute specification in a reissue application, while the present petition requests entry of the substitute specification filed on August 27, 2003. Accordingly, this petition is being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.125(d). 37 CFR 1.173(a)(1) requires the filing of the specification in the form of "a copy of the printed patent, in double column format, each page on only one side of a single sheet of paper." The substitute specification filed on August 27, 2003, is not a copy of the printed patent in double column format. Accordingly, this petition is also being considered as a petition under 37 CFR 1.183 for a waiver of 37 CFR 1.173(a)(1).

On August 27, 2003, a substitute specification was filed together with an amendment. The reason for its submission was stated as "A substitute specification is filed herewith to make corrections to the application." It is noted that there is no further comment by the examiner, regarding the substitute specification, noted in the application.

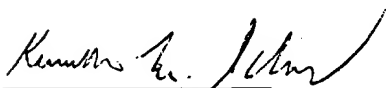
Petitioner is now requesting waiver of the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) based on the fact that "In several of the applications, the Examiner required a substitute specification because of the length of the specification and the number of amendments, and indicated by telephone that substitute specifications would be required in all of the related reissue

applications.”¹ The petitioner continues by stating “..in the parent reissue application 09/244,037 the replacement paragraph amendments were filed on April 30, 2003. Then in the Office Action mailed July 29, 2003, the Examiner required a substitute specification. Also in related reissue application 09/662,695, which like the present application is a reissue application of U.S. Patent 5,600,672 and a divisional application of reissue application 09/244,037, the replacement paragraph amendments filed on May 7, 2003 were denied entry and a substitute specification was required in the Office Action mailed May 27, 2003.”

The above is considered to be sufficient basis for granting the present petition. The rule will be waived, since there is no other way to present the substitute specification required by the examiner in the companion applications, and that requirement for the substitute specification by the examiner is deemed appropriate.

CONCLUSION

1. The request under 37 CFR 1.183 to waive the requirements of 37 CFR 1.125(d) and 37 CFR 1.173(a)(1) is granted.
2. The substitute specification filed on August 27, 2003, is accepted, and will be entered by the Technology Center.
3. The reissue application file is being forwarded to Technology Center 2600 for further action as appropriate.
4. Telephone inquiries with regard to this decision should be directed to the undersigned at (571) 272-7710.



Kenneth M. Schor
Senior Legal Advisor
Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examining Policy

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October 21, 2004

¹ No other record of the referenced telephone conversation can be found in this application file.